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Maria Muhlbauer
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Signature
October 19, 2006
Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/811,601
Applicant(s) : Siegfried Fischer
Filed : March 29, 2004
Title : Knife Holder For A Cutting Knife Of A Microtome
TC/A.U. : 3724
Examiner : Edward F. Landrum
Docket No. : 37105.0052

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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This Appeal Brief follows a "Notice of Appeal" filed June 23, 2006, and is accompanied by a Petition for a Two-Month Extension of Time (in duplicate), a Fee Transmittal, a check in the amount of \$500 as payment of the fee required under 37 CFR 41.20(b)(2), a check in the amount of \$450 as payment of the fee required under 37 CFR 1.17(a)(2), and an acknowledgment postcard.

The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account Number 08-2442.

I. REAL PARTY IN INTEREST

The real party in interest is Leica Microsystems Nussloch GmbH, assignee of the present application. An assignment document is recorded in the USPTO at Reel 015162 / Frame 0047.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences.

III. STATUS OF CLAIMS

The application as filed included claims 1-9.

Claims 1, 3, and 7-9 are rejected and are being appealed.

Claims 2 and 4-6 are cancelled.

IV. STATUS OF AMENDMENTS

A Final Office Action was mailed March 20, 2006. Applicant filed an "Amendment After Final" on July 20, 2006. As indicated in an Advisory Action mailed August 3, 2006, the proposed amendments were not entered for purposes of this appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is the only independent claim on appeal. Claim 1 is directed to a knife holder for a cutting knife of a microtome (the claimed invention does not include the cutting knife to be held, which is considered a "work piece" in relation to the claimed subject matter). The claimed knife holder comprises a pressure plate (3) for locking the cutting knife in the knife holder and for discharging a cut sample, and a U-shaped frame (4) mounted detachably on the pressure plate by magnets (6). The U-shaped frame is open toward the knife edge of the cutting knife. The detachably mounted frame and the pressure plate cooperate to form a water pan for receiving cut samples, which are very thin sections of a sample material. Plate (3) and frame (4) are shown in Figs. 1 and 2.

Claim 3 further limits claim 1 by specifying that the U-shaped frame is a one-piece component, thereby making it easy to manufacture because there is no need to provide fluid seals between pieces of the frame. See specification at page 2, lines 24-25.

Claim 7 sets forth additional claimed structure to the structure defined by claim 1, namely a fluid seal (7) between the frame (4) and the pressure plate (3). Fluid seal (7) is described at page 3, lines 1-2 and page 4, lines 17-18, and is shown in Fig. 2.

Claim 8 also adds claimed structure to the invention defined by claim 1, namely a bail (8) pivotably mounted to the frame for selectively covering the knife edge to protect users from cuts. Bail (8) is described at page 3, lines 3-5 and page 4, lines 12-14, and is shown in Figs. 1-2.

Claim 9 further limits claim 1 by requiring that the U-shaped frame include two parallel limbs (9) that are each wedge-shaped. This subject matter is described at page 3, lines 6-11 and 28, and at page 4, lines 7-11. The subject matter is also apparent from Figs. 1 and 2.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are three grounds of rejection to be reviewed on appeal:

- 1) Claims 1, 3, 7, and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,035,460 (Borter);
- 2) Claim 1, 3, 7, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,551,326 (Goodman) in view of U.S. Patent No. 5,351,812 (Eagon); and
- 3) Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over “the modified device of Goodman” in view of U.S. Patent Application Publication No. 2001/0003938 (Heid).

VII. ARGUMENT

1. *Rejection of claims 1, 3, 7, and 9 under 35 U.S.C. § 102(b) as being anticipated by Borter*

A. *Claims 1 and 7*

With respect to the stated rejection, claims 1 and 7 stand or fall together. It is applicant's respectful position that Borter does not anticipate or suggest the invention defined by claims 1 and 7 because Borter does not disclose several limitations found in claim 1.

Borter describes a shower door assembly that adjusts for installation in openings of different widths. The examiner identifies the shower door (16) as corresponding to the claimed "pressure plate," and the door frame surrounding the shower door as corresponding to the claimed "U-shaped frame." The rejection asserts that the shower door is capable of holding a razor, as by a suction cup, to function as a microtome (see US 5839198 - McCoy).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is respectfully argued that when this standard is applied, there are limitations of claims 1 and 7 that are not described in Borter.

Claim 1 requires "a pressure plate (3) for locking the cutting knife (2) in the knife holder (1) ...". In Borter, the shower door is not for locking the razor in "the knife holder." In fact, as stated in the McCoy patent,

The suction cup allows the razor unit to be affixed to any surface. In the preferred usage, the razor unit is temporarily affixed to a vertical surface such as a shower wall. The user may repeatedly remove and affix the razor unit to the surface as desired. This embodiment is especially preferred for individuals who use the razor while standing in a shower because it allows for quick and easy placement of the razor in a safe location on a vertical surface while the user performs other functions, such as lathering with shaving cream.

See McCoy at column 2, lines 35-43. Therefore, the door provides a placement surface on which the razor may be affixed between uses, but it does not function to lock the cutting knife (razor) in any manner as is necessary for cutting thin sections for microscopic observation.

By contrast, as described in the present specification, pressure plate (3) locks the cutting knife (2) in knife holder (1) by clamping the cutting knife. See paragraph [0021] and Figs. 1 and 2.

Claim 1 further requires “a U-shaped frame (4) mounted detachably on the pressure plate (3) by magnets (6)...”. The examiner identifies the frame surrounding the shower door and the magnets (24) of Borter as meeting this limitation. The frame surrounding the shower door consists of vertical side wall jamb sections (10) and (11) and horizontal shower base (13) extending between the side wall jamb sections (10) and (11). Door (16) is mounted on the frame by a top pivot (43) associated with jamb section (11) and a bottom pivot (44) associated with shower base (13); both pivots can be seen in Fig. 2, although they are not numbered in that figure. The side jambs (10) and (11) and the base (13) are anchored to the shower wall and entryway floor of the shower by pan head screws 31. Continuous magnets (24) of Borter are part of a spring-loaded latching mechanism acting between the shower door and side wall jamb section (10). The U-shaped frame (members (10), (11), (13)) is not detachably mounted on door (16) by magnets (24) as required by claim 1 because separation of the opposing magnets (24) does not detach the U-shaped frame from the shower door.

Claim 1 includes a final limitation “wherein the frame (4) and the pressure plate (3) cooperate to form a water pan.” The rejection states that the “frame” and the “pressure plate” identified in Borter “cooperate to form a water tight seal.” The frame and shower door do not, however, cooperate to form a water pan. In this regard, the examiner has stated “Furthermore, generally during showering water is found at the bottom of the shower, therefore this can be considered a water pan, as things dropped in the shower can potentially float in the water found on the shower floor.” Advisory Action mailed July 24, 2006, at page 2. This argument ignores the claim language because the “frame” of Borter (members (10), (11), (13)) and “pressure plate” of Borter (door (16)) do not cooperate to form the bottom of the shower which the examiner considers “a water pan.”

Claim 7 depends from claim 1 and includes all the limitations of claim 1. Therefore, the above arguments apply equally to claim 7.

In view of the foregoing, it is clear that claims 1 and 7 are patentable over Borter. Reversal of the rejection is respectfully sought.

B. Claim 3

Claim 3 depends from claim 1, and thus is patentable over Borter for the reasons given above with respect to claim 1. Moreover, the frame identified in Borter (members (10), (11), (13)) is not made as a one-piece component as required by claim 3. Therefore, applicant asks that the rejection of claim 3 as being anticipated by Borter be reversed.

C. Claim 9

Claim 9 depends from claim 1, and thus is patentable over Borter for the reasons detailed above concerning claim 1. Claim 9 further requires that “the U-shaped frame includes two parallel limbs (9), and each of the two limbs (9) is wedge-shaped.” In keeping with the stated rejection, the two parallel limbs in the identified U-shaped frame of Borter are vertical side wall jamb sections (10) and (11). With regard to these, the examiner asserts “Figure 9, shows each side wall jamb sections tapering until they meet the door, and therefore they are wedge shaped.” Advisory Action mailed July 24, 2006, at page 2. Applicant has examined Fig. 9 of Borter, and the rest of Borter, and finds that vertical side wall jamb sections (10) and (11) are each formed as an elongated channel member having a U-shaped cross-section. Applicant finds no support for the examiner’s assertion that these members are wedge-shaped. Consequently, applicant respectfully requests that this rejection of claim 9 be reversed.

2. Rejection of claims 1, 3, 7, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Eagon

With respect to the stated rejection, claims 1, 3, 7, and 9 stand or fall together. It is applicant’s respectful position that the rejection should be reversed for reasons given below.

Goodman is discussed in the Background section of applicant’s specification at paragraphs [0008]-[0009]. As explained by applicant, the disclosure of Goodman relates to embodiments wherein a water “boat” is arranged directly on the knife, an arrangement that is not possible in situations where the knife is clamped into the knife holder by a pressure plate.

The examiner, however, argues that upper surface (76) of knife (73) in Goodman is “a pressure plate (3) for locking the cutting knife (2) in the knife holder (1) ...” in a accordance with claim 1. This interpretation is flawed because upper surface (76) is an integral

part of the work piece (the cutting knife), and is not a component of the knife holder described in Goodman. Claim 1 is directed to “A knife holder (1) for a cutting knife (2) of a microtome...”. As admitted by the examiner, the cutting knife (blade) itself is not positively claimed. See Advisory Action mailed July 24, 2006, at page 2. The cutting knife is separate from the claimed knife holder and in fact is a work piece held by the claimed knife holder. Therefore, surface (76) of knife (73) is not “a pressure plate” for locking knife (73) in a knife holder of which the pressure plate is a constituent part. Stated another way, surface (76) cannot exert pressure on itself. Thus, surface (76) of Goodman cannot be a “pressure plate” in accordance with claim 1.

It is also pointed out by applicant that one of skill in the art, at the time the invention was made, would not be motivated to replace the C-shaped leaf spring 96 of Goodman (see Figs 4-6) with magnets because the boat (74) of Goodman is intended to mount on both a steel histological knife or a glass Ralph knife. See Goodman at column 5, lines 63-65; see also column 6, lines 31-33. In all likelihood, the magnet limitation in applicant’s claimed invention directed the examiner to Eagon through improper hindsight, because there is nothing in Goodman that would suggest using a magnet, as this would render the boat of Goodman inoperable for a significant portion of knives (glass or diamond knives).

In view of the foregoing, the rejection of claims 1, 3, 7, and 9 should be reversed by the Board, which action is respectfully requested.

3. *Rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over “the modified device of Goodman” in view of Heid*

Claim 8 depends from claim 1 and includes all the limitations thereof. Applicant reiterates the arguments made in the previous section with respect to claim 1 and modification of Goodman according to Eagon. The deficiencies noted above are not cured by Heid.

There is an additional reason why claim 8 is not rendered obvious by the asserted references. Claim 8 requires “a bail (8) pivotably mounted to the frame (4) for selectively covering the knife edge (5) to protect users from cuts” (emphasis added). The bail in Heid (guard yoke (7)) is pivotably mounted to clamping plate (4) of Heid (see Fig. 1), not to any U-

shaped frame. Accordingly, Heid would suggest pivotably mounting bail (8) to pressure plate (3) in the present invention, not to frame (4) as claimed.

On the grounds put forth above, applicant respectfully seeks reversal of the rejection of claim 8.

VIII. CLAIMS APPENDIX

1. A knife holder (1) for a cutting knife (2) of a microtome having a knife edge (5) for cutting samples, the knife holder comprising:
 - a pressure plate (3) for locking the cutting knife (2) in the knife holder (1) and for discharging the cut sample; and
 - a U-shaped frame (4) mounted detachably on the pressure plate (3) by magnets (6) and open toward the knife edge (5) of the cutting knife (2);
 - wherein the frame (4) and the pressure plate (3) cooperate to form a water pan.
3. The knife holder (1) as defined in Claim 1, wherein the frame (4) is a one-piece component.
7. The knife holder (1) as defined in Claim 1, further comprising a fluid seal (7) between the frame (4) and the pressure plate (3).
8. The knife holder (1) as defined in Claim 1, further comprising a bail (8) pivotably mounted to the frame (4) for selectively covering the knife edge (5) to protect users from cuts.
9. The knife holder (1) as defined in Claim 1, wherein the U-shaped frame includes two parallel limbs (9), and each of the two limbs (9) is wedge-shaped.

IX. EVIDENCE APPENDIX

There is no appended evidence.

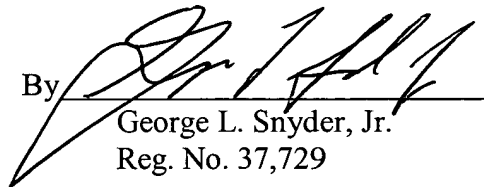
X. RELATED PROCEEDINGS APPENDIX

There are no other related proceedings.

Respectfully submitted,

HODGSON RUSS LLP

By

A handwritten signature in black ink, appearing to read "George L. Snyder, Jr.", is written over a horizontal line.

George L. Snyder, Jr.
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GLS/

Enclosures: Fee Transmittal
Petition For Two-Month Extension (in duplicate)
Check in the amount of \$500 (for Appeal Brief)
Check in the amount of \$450.00 (for Two-Month Extension)
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